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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,788	07/14/2003	Roland Feola	02/041 VAT	7344

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

Office Action Summary	Application No. 10/618,788	Applicant(s) FEOLA ET AL.	
	Examiner Patrick D. Niland	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/14/03</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Claims 6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claim 6 recites "obtainable". It is unclear what other products made by other processes are intended to be encompassed by claim 6 and its recitation of "obtainable". It would require undue experimentation to determine all of the potentially infinite number of products by other processes which are intended to be encompassed by the instant claim 6. "Obtained" is acceptable.

The following are supporting descisions for rejecting "obtainable" and similar terms as indefinite.

1. Atlantic Thermoplastics Co. Inc. v Faytex Corp. 23 USPQ 2nd 1481 (1486).

In footnote 6, on page 1486, referring to Cochrane v Badische Aniline and Soda Fabrik (BASF), 11 US 293, the court stated "...because artificial alizarine can take different forms, BASF's claim would be indefinite unless limited to the described process".

The claim referred to is

"Artificial alizarine produced form anthracene or its derivatives by either of the methods described herein or any other method producing a like result."

2. Ex parte Tanksley 26 USPQ 2nd 1389

"A claim is indefinite if undue experimetnation is involved to determine boundaries of protection".

This rationale is applicable to polymers obtainable by a stated process because any variation in any parameter within the scope of the claimed process would change the polymer

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produced. One who made or used a polymer made by a process other than the process recited in the claim would have to produce polymers using all possible parameters within the scope of the claims (temperature, pressure, diluents, component ratios, feed ratios, etc.) and then extensively analyze each product, to determine if his polymer was obtainable by a process within the claimed process.

3. Purdue Research v Watson 1959 CD 124 (Dist Ct) affirmed by CCPA 120 USPQ 521.

"Preparable by" was held to not particularly point out and distinctly claim the invention.

"When one has produced a composition of matter where it is not possible to define its characteristics which make it inventive except by reference to the process by which it is produced, one is permitted to so claim the composition produced by the process referred to in the claims. When the composition is thus claimed in terms of the process of its preparation, the product cannot be defined in such a manner as to assert a monopoly on the product by whatever means produced.

B. The instant claim 9 recites "where appropriate". It is unclear how to determine when the limitation following "where appropriate" is appropriate, which makes the scope of the instant claim 9 unclear.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Publication No. 2002/0077389 A1 Dworak et al..

Dworak et al. discloses a composition falling within the scope of that of the instant claims where the polyol of the references condensation product AB (page 1, sections [0006] through [0012]; page 2, sections [0013] through [0020], of which [0015] encompasses the use of excess OH functional polyurethane and said excess of OH functional urethane reads on component C of the instant claims as it is not removed from the compositions of Dworak, and the OH functional urethane which results when AB is made with excess OH functional resin also falls within the scope of the instantly claimed components AB and C. Note that polymers are mixtures of different molecules and some of the molecules of the reference may be deemed as being AB and some as C. See the definitions of average molecular weights and average functionalities, etc. in polymer chemistry texts. See page 3, section [0024]; page 4, sections [0027] of which the diisocyanates disclosed by the patentee encompass those of the instant claims. It does not require too much picking and choosing from the diisocyanates of the reference to arrive at those polyisocyanates of the instant claims because the instantly claimed polyisocyanates are those which are most typically employed in polyurethane coatings, as evidenced by their use in the exemplified polyurethanes of the reference and page 2, section [0018]. These polyurethanes will necessarily have terminal OH groups according to the instant claim 2. The instantly claimed

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component D is encompassed by page 4, section [0032]. These curatives are necessarily “water dilutable” according to the instant claim 4 as they are used in water. The instant claim 5 is encompassed by page 4, section [0027]. The instant claim 6 is encompassed by page 1, sections [0010] through [0012] and page 2, section [0015]. Page 2, section [0015] encompasses the instant claim 7. All of the mass fractions recited by the reference and the required use of curatives of the reference encompasses the instant claim 8. The method of claim 9 is done above. The instant claim 10 intended use is recited in the abstract and the above composition meets the limitations of the instant claim 10 as it is capable of being an automotive surfacer.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2002/0077389 A1 Dworak et al..

Dworak et al. discloses a composition falling within the scope of that of the instant claims where the polyol of the references condensation product AB (page 1, sections [0006] through [0012]; page 2, sections [0013] through [0020], of which [0015] encompasses the use of excess OH functional polyurethane and said excess of OH functional urethane reads on component C of the instant claims as it is not removed from the compositions of Dworak, and the OH functional urethane which results when AB is made with excess OH functional resin also falls within the scope of the instantly claimed components AB and C. Note that polymers are mixtures of different molecules and some of the molecules of the reference may be deemed as being AB and some as C. See the definitions of average molecular weights and average functionalities, etc. in polymer chemistry texts. See page 3, section [0024]; page 4, sections [0027] of which the diisocyanates disclosed by the patentee encompass those of the instant claims. It does not require too much picking and choosing from the diisocyanates of the reference to arrive at those

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polyisocyanates of the instant claims because the instantly claimed polyisocyanates are those which are most typically employed in polyurethane coatings, as evidenced by their use in the exemplified polyurethanes of the reference and page 2, section [0018]. These polyurethanes will necessarily have terminal OH groups according to the instant claim 2. The instantly claimed component D is encompassed by page 4, section [0032]. These curatives are necessarily "water dilutable" according to the instant claim 4 as they are used in water. The instant claim 5 is encompassed by page 4, section [0027]. The instant claim 6 is encompassed by page 1, sections [0010] through [0012] and page 2, section [0015]. Page 2, section [0015] encompasses the instant claim 7. All of the mass fractions recited by the reference and the required use of curatives of the reference encompasses the instant claim 8. The method of claim 9 is done above. The instant claim 10 intended use is recited in the abstract and the above composition meets the limitations of the instant claim 10 as it is capable of being an automotive surfacer.

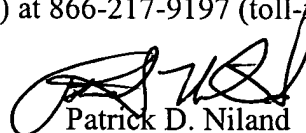
It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the above discussed combinations of ingredients and amounts thereof because they are encompassed by the reference and would have been expected to give a coating having the properties described therein.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
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